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10/661,504

09/15/2003

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EXAMINER

CHEN, QING

ART UNIT

PAPER NUMBER

2191

MAIL DATE

DELIVERY MODE

10/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/661,504

Applicant(s)

SUGIYAMA, TAKAAKI

Examiner

Qing Chen

Art Unit

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,6-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,6-8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office action is in response to the amendment filed on July 10, 2008.
2. **Claims 1, 4, 6-8, and 10** are pending.
3. **Claims 1, 6-8, and 10** have been amended.
4. **Claims 2, 3, 5, and 9** have been cancelled.
5. The objections to Claims 1 and 4-9 are withdrawn in view of Applicant's amendments to the claims or cancellation of the claims. However, Applicant's amendments to Claim 10 fail to address the objection due to improper antecedent basis. Accordingly, this objection is maintained and further explained hereinafter.
6. The 35 U.S.C. § 112, second paragraph, rejections of Claims 7-10 are withdrawn in view of Applicant's amendments to the claims or cancellation of the claims.
7. The 35 U.S.C. § 101 rejections of Claims 1 and 4-6 are withdrawn in view of Applicant's arguments or cancellation of the claims.

Response to Amendment

Specification

8. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

9. **Claims 7 and 10** are objected to because of the following informalities:

- **Claim 7** contains a typographical error: “the cooperation instruction information is created based a selection” should presumably read -- the cooperation instruction information is created based on a selection --.
- **Claim 10** recites the limitation “the service acquisition step.” Applicant is advised to change this limitation to read “the plural services acquisition step” for the purpose of providing it with proper explicit antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. **Claims 7, 8, and 10** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation “the respective restriction value table.” There is insufficient antecedent basis for this limitation in the claim. In the interest of compact prosecution, the Examiner subsequently interprets this limitation as reading “the respective restriction value tables” for the purpose of further examination.

Claims 8 and 10 depend on Claim 7 and, therefore, suffer the same deficiency as Claim 7.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. **Claims 1, 4, 7, and 8** are rejected under 35 U.S.C. 102(b) as being anticipated by **US 2002/0052796 (hereinafter “Tadokoro”)**.

As per **Claim 1**, Tadokoro discloses:

- a service acquisition unit that acquires plural services available to a user by using user information, wherein the user information is updated when at least one of the plural services is selected, and the plural services available to the user being determined by the content of a restriction value table expressing restrictions on execution of services and values of the user information are checked against values of the restriction value table (*see Figure 4: 301; Figures 6 and 8; Paragraph [0056], “Each user, who is a customer of services provided by the systems in this embodiment can access the service providing system 101 by executing the service access program 311, e.g. browser, in his/her service access apparatus so as to receive a desired service therefrom.”; Paragraph [0059], “The system in this embodiment further enables the user of a*

service access apparatus 301, which is a customer of the system, to use the services of a company cooperated with the service providing company that operates this service providing system 101 in addition to the services provided by the service providing system 101.” and “... the user can receive a service of the cooperated company just like a service provided from the service providing system 101 without knowing the difference.”; Paragraph [0063], “FIG. 6 is a configuration of the service information classified by user 132 stored in the data memory 117 of the service providing system 101. The service information classified by user 132 is a table for storing information denoting services accessible, i.e., allowed for use by the user. The service information classified by user 132 includes fields of user code 601, service code 602, service name 603, service user code 604, and service user name 605.”; Paragraph [0068], “The common information of state 134 is a table for storing information related to the services (including not only common services, but also services classified by area and by cooperated company) used by all the users. The common information of state 134 includes fields of user code 801, service code 802, cooperated company user code 803, state code 804, and service providing time 805.”; Paragraph [0069], “The state code 804 stores the various states that occur when the user uses a service. For example, the state code 804 stores such states as login and logout, or start and end. The service providing time 805 stores a time at which the subject state occurs.”);

- a cooperation instruction information creation unit that creates the cooperation instruction information by using the plural services acquired by the service acquisition unit (see Figure 4: 311); and

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- a display unit that displays a service list, the service list including a list of the plural services available to the user which the user can use at present (*see Figure 3: 317; Figure 12; Paragraph [0077], "FIG. 12 shows an example of the screen svc01 for starting the common service to be displayed on the display block 317 of the service access apparatus 301.";* *Paragraph [0079], "In FIG. 12, numeral 1220 denotes the common service announcement field and 1230 denotes the service announcement field classified by area."*),
- wherein each of the plural services performs a specific processing on document data (*see Figure 12*),
- the service acquisition unit acquires at least one of the plural services available to the user for each of functions constituting a job flow that is created and the cooperation instruction information creation unit provides for selection of at least one of the plural services available to the user corresponding to each of the functions (*see Figures 11-18; Paragraph [0074], "FIGS. 11 through 17 show examples of the service access screen displayed at the system in this embodiment. FIG. 18 shows an example of the processing order of management of service providing in the system in this embodiment. Hereinafter, a description will be made for each screen displayed on the display block 317 of the service access apparatus 301 when processings are executed sequentially in the order shown in FIG. 18."*), and
- the plural services available to the user and the user information are updated with each selection (*see Figure 8; Paragraph [0069], "The state code 804 stores the various states that occur when the user uses a service. For example, the state code 804 stores such states as login and logout, or start and end. The service providing time 805 stores a time at which the subject state occurs."*).

As per **Claim 4**, the rejection of **Claim 1** is incorporated; and Tadokoro further discloses:

- an inquiry unit that inquires of respective service processing devices each storing a restriction value table expressing restrictions on execution of services, by transmitting user information, as to whether the user can use the services of the respective service processing devices (*see Figure 4: 301; Figure 10; Paragraph [0059], “The system in this embodiment further enables the user of a service access apparatus 301, which is a customer of the system, to use the services of a company cooperated with the service providing company that operates this service providing system 101 in addition to the services provided by the service providing system 101.”; Paragraph [0072], “FIG. 10 is a configuration of the user information of cooperated company 231 stored in the data memory 217 of the service providing system 101. The user information of cooperated company 231 is a table for storing preset items of user code and password with which the service providing system of cooperated company 201 accepts an access. The user information of cooperated company 231 includes fields of user code of cooperated company 1001, password of cooperated company 1002, account holder code of cooperated company 1003, and account holder name of cooperated company 1004.”*),
- wherein the service acquisition unit acquires the plural services on the basis of an inquiry result of the inquiry unit (*see Paragraph [0056], “Each user, who is a customer of services provided by the systems in this embodiment can access the service providing system 101 by executing the service access program 311, e.g. browser, in his/her service access apparatus so as to receive a desired service therefrom.”; Paragraph [0059], “The system in this embodiment further enables the user of a service access apparatus 301, which is a customer of*

the system, to use the services of a company cooperated with the service providing company that operates this service providing system 101 in addition to the services provided by the service providing system 101.”).

Claim 7 is a cooperation instruction information creation method claim corresponding to the cooperation instruction information creation device claim above (Claim 1) and, therefore, is rejected for the same reason set forth in the rejection of Claim 1.

As per **Claim 8**, the rejection of **Claim 7** is incorporated; and Tadokoro further discloses:

- wherein in the cooperation instruction information creation step, services constituting the job flow are selected from the acquired plural services, and the cooperation instruction information is created by using the selected services (*see Figures 11-18; Paragraph [0074], “FIGS. 11 through 17 show examples of the service access screen displayed at the system in this embodiment. FIG. 18 shows an example of the processing order of management of service providing in the system in this embodiment. Hereinafter, a description will be made for each screen displayed on the display block 317 of the service access apparatus 301 when processings are executed sequentially in the order shown in FIG. 18.”).*

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 6 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tadokoro** in view of **US 6,851,115 (hereinafter “Cheyer”)**.

As per **Claim 6**, the rejection of **Claim 1** is incorporated; however, Tadokoro does not disclose:

- wherein the service acquisition unit determines and acquires a service having minimum restrictions for each of the functions constituting the job flow, and the cooperation instruction information creation unit creates the cooperation instruction information by associating the respective plural services acquired by the service acquisition unit with the respective functions constituting the job flow.

Cheyer discloses:

- wherein the service acquisition unit determines and acquires a service having minimum restrictions for each of the functions constituting the job flow, and the cooperation instruction information creation unit creates the cooperation instruction information by associating the respective plural services acquired by the service acquisition unit with the respective functions constituting the job flow (*see Column 15: 66 and 67 to Column 16: 1-17, “Advice parameters preferably give constraints or guidance to the facilitator in completing and interpreting the goal. For example, a solution_limit parameter preferably allows the requester to say how many solutions it is interested in; the facilitator and/or service providers are free to use this information in optimizing their efforts. Similarly, a time_limit is preferably used to say how*

long the requester is willing to wait for solutions to its request ...”; Column 16: 39-43, “In a preferred embodiment of the present invention, when a facilitator receives a compound goal, its job is to construct a goal satisfaction plan and oversee its satisfaction in an optimal or near optimal manner that is consistent with the specified advice.” and 62-67 to Column 17: 1 and 2, “With further reference to FIG. 7, each registered agent may be optionally associated with one or more capabilities, which have associated Capability Declaration fields 708 in the parent facilitator Agent Registry 702. These capabilities may define not just functionality, but may further provide a utility parameter indicating, in some manner (e.g., speed, accuracy, etc), how effective the agent is at providing the declared capability.”).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Cheyer into the teaching of Tadokoro to include wherein the service acquisition unit determines and acquires a service having minimum restrictions for each of the functions constituting the job flow, and the cooperation instruction information creation unit creates the cooperation instruction information by associating the respective plural services acquired by the service acquisition unit with the respective functions constituting the job flow. The modification would be obvious because one of ordinary skill in the art would be motivated to provide an optimal or near optimal job flow (*see Cheyer – Column 16: 39-43*).

Claim 10 is rejected for the same reason set forth in the rejection of Claim 6.

Response to Arguments

16. Applicant's arguments with respect to Claims 6 and 10 have been considered but are moot in view of the new ground(s) of rejection.

In the Remarks, Applicant argues:

a) Tadokoro does not teach the combinations of the above features at least because the allegedly corresponding features of Tadokoro deal with determining whether a user has access to a particular service, and, if the service providing system does not have the specific service, managing access to another service providing system to provide this specific service to the user (see paragraph [0008]). As discussed in paragraph [0063] of Tadokoro, service information classified by user may be stored in a table denoting services accessible. However, such features do not correspond to at least the user information is updated when at least one of the plural services is selected, or the plural services available to the user and the user information are updated with each selection.

Examiner's response:

a) Examiner disagrees. With respect to the Applicant's assertion that features in Tadokoro do not correspond to at least the user information is updated when at least one of the plural services is selected or the plural services available to the user and the user information are updated with each selection, the Examiner respectfully submits that Tadokoro clearly discloses "wherein the user information is updated when at least one of the plural services is selected" and "the plural services available to the user and the user information are updated with each

selection” (see Figure 8; Paragraph [0068], “The common information of state 134 is a table for storing information related to the services (including not only common services, but also services classified by area and by cooperated company) used by all the users. The common information of state 134 includes fields of user code 801, service code 802, cooperated company user code 803, state code 804, and service providing time 805.”; Paragraph [0069], “The state code 804 stores the various states that occur when the user uses a service. For example, the state code 804 stores such states as login and logout, or start and end. The service providing time 805 stores a time at which the subject state occurs.”).

In the Remarks, Applicant argues:

b) In reviewing the anticipation standard, the Federal Circuit has stated “[t]o anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim.” Brown v. 3M, 265 F.3d 1349, 1351, 60 USPQ2d 1375 (Fed. Cir. 2001), cert. denied, 122 S. Ct. 1436 (2002) (emphasis added). See also Sandisk Corp. v. LexarMedia, Inc., 91 F. Supp. 2d 1327, 1336 (N.D. Calif. 2000) (stating that “[u]nless all the elements are found in a single piece of prior art in exactly the same situation and united the same way to perform the identical function, there is no anticipation.”) and Aero Industries Inc. v. John Donovan Enterprises-Florida Inc., 53 USPQ2d 1547, 1555 (S.D. Ind. 1999) (stating that “[n]ot only must a prior patent or publication contain all of the claimed elements of the patent claim being challenged, but they ‘must be arranged as in the patented device’ ”). This standard for anticipation is also set forth in MPEP §2131, which states that “the identical invention must be shown in as much detail as is contained in the ... claim.”

The above standard is not met by the application of Tadokoro to the pending claims at least because Tadokoro does not teach every feature of the pending claims, arranged as in the claims.

Examiner's response:

b) Examiner disagrees. With respect to the Applicant's assertion that Tadokoro does not teach every feature of the pending claims, arranged as in the claims, the Examiner respectfully submits MPEP § 2131 with emphasis added for purposes of convenience in discussion and illustration:

MPEP § 2131 Anticipation — Application of 35 U.S.C. 102(a), (b), and (e)

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >**"When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art."** *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02.< **"The identical invention must be shown in as complete detail as is contained in the ... claim."** *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). **The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required.** *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01.

According to the section of the MPEP provided above, the Examiner respectfully submits that the Non-Final Rejection (mailed on 04/11/2008) has met the requirements pursuant to MPEP § 2131. In making the rejections, the Examiner has set forth the claims as being anticipated by Tadokoro, either expressly or inherently described. Examiner has also clearly presented the relevant citations by providing the specific figure numbers, paragraph numbers, and the corresponding text in Tadokoro as teaching the claimed features. Furthermore, features of Tadokoro's invention are arranged as required by the claims since Tadokoro teaches all of the structural elements of the claimed invention.

Therefore, for at least the reason set forth above, the rejections made under 35 U.S.C. § 102(b) with respect to Claims 1 and 7 are proper and therefore, maintained.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Qing Chen whose telephone number is 571-270-1071. The Examiner can normally be reached on Monday through Thursday from 7:30 AM to 4:00 PM. The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Wei Zhen, can be reached on 571-272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Q. C./

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Examiner, Art Unit 2191

/Wei Y Zhen/

Supervisory Patent Examiner, Art Unit 2191